



UNITED STATES PATENT AND TRADEMARK OFFICE

N.K.
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,932	11/21/2001	Robert J. Sicurelli JR.	CONTINUATION-11-D1	4222

4988 7590 08/27/2003

ALFRED M. WALKER
225 OLD COUNTRY ROAD
MELVILLE, NY 11747-2712

EXAMINER

WILSON, JOHN J

ART UNIT	PAPER NUMBER
----------	--------------

3732

DATE MAILED: 08/27/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,932

Applicant(s)

SICURELLI ET AL.

Examiner

John J. Wilson

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-36 and 38-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-36 and 38-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 3732

DETAILED ACTION

Renumbering of Claims

The amendment of July 7, 2003 added new claims, however, there is no claim 65. The examiner has renumbered claims 66-70 to be claims 65-69 respectively.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 64 and 65 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure, as filed, does not teach a "tapered series of truncated conical section", and therefore, this limitation is held to be improper new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 57 and 59-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 57, 59 and 61, "and core inelastic

Art Unit: 3732

post" lacks proper antecedent basis within the claims. In claim 60, "dental reinforcement post" lacks proper antecedent basis with the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33-35, 40, 50, 53, 55-58, 60, 62, 63 and 66-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (5564929). Alpert shows a post 28 made from a non-metallic material and is non-woven, column 3, lines 3-15. The post is prefabricated, column 3, lines 60-68 and column 4, lines 1-4, because the resin is added before inserting in a root canal. To not use a traction pulling force is an obvious matter of choice in not using a method step in the process of making the claimed structure to one of ordinary skill in the art. The type of fiber glass used is an obvious matter of choice in known materials to one of ordinary skill in the art. As to claim 40, see rounded end in Fig. 7. As to claim 50, to call the post a pin is an obvious matter of choice in terminology to the skilled artisan. As to claim 53, see the plurality of posts in Fig. 8.

Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (5564929) as applied to the claims above, and further in view of Al Kasem

Art Unit: 3732

(5326264). Alpert does not show using an opaque material. Al Kasem teaches using an opaque filler, column 18, line 19. It would be obvious to one of ordinary skill in the art to modify Alpert to include the use of an opaque material as shown by Al Kasem in order to make use of known materials for best matching the tooth.

Claims 41-49, 59, 61, 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (5564929) as applied to the claims above, and further in view of Reynaud et al (5328372). Alpert does not show a tapered end. Reynaud teaches a tapered end, Fig. 1. It would be obvious to one of ordinary skill in the art to modify Alpert to include a tapered end as shown by Reynaud in order to make use of art known shapes to better fit within a tooth. As to claims 42-49, Alpert does not show texturing. Reynaud shows a roughness, column 4, line 22. The specific manner in which the surface is textured is an obvious matter of choice in the shape of the texturing used to the skilled artisan. The specific way of forming the textured surface is an obvious matter of choice in process steps used to obtain a known structure. As to claim 64, Alpert does not show a series of truncated conical sections. Reynaud shows a series of truncated conical sections as shown in the drawings. It would be obvious to one of ordinary skill in the art to modify Alpert to include the sections as shown by Reynaud in order to make use of art known shapes to better fit within a tooth.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (5564929) as applied to the claims above, and further in view of Kennard (3903603).

Art Unit: 3732

Alpert does not show using a loop. Kennard teaches using a loop shape, column 2, lines 55-57. It would be obvious to one of ordinary skill in the art to modify Alpert to include a loop shape as shown by Kennard in order to make use of art known shapes for better holding within a tooth.

Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (5564929) as applied to the claims above, and further in view of Weissman (5326263). Alpert does not show an end shaped to direct light. Weissman shows an end shaped to direct light, Fig. 6. It would be obvious to one of ordinary skill in the art to modify Alpert to include a shaped end as shown by Weissman in order to direct light. To shape the end by polishing is an obvious matter of choice in the process used to obtain a known structure to the skilled artisan.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 3732

Claims 33-35, 38, 39, 42-50, 55-58, 60, 62, 63 and 66-69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No. 5,741,139. Although the conflicting claims are not identical, they are not patentably distinct from each other because to use a non-woven material is an obvious matter of choice in the material used to one of ordinary skill in the art. To not include traction pulling in the process of forming is an obvious matter of choice in not using a method of step of making the claimed structure. The type of fiber glass used is an obvious matter of choice in known materials to one of ordinary skill in the art. To call a pin is an obvious matter of choice in terminology to the skilled artisan.

Claims 42-49, 64 and 65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No. 5,741,139 in view of Reynaud et al (5328372). The '139 claims teach the structure as described above, however, do not show roughening nor the truncated cylindrical shape. Reynaud shows a roughness, column 4, line 22. The specific manner in which the surface is textured is an obvious matter of choice in the shape of the texturing used to the skilled artisan. The specific way of forming the textured surface is an obvious matter of choice in process steps used to obtain a known structure. Reynaud shows a series of truncated conical sections as shown in the drawings. It would be obvious to one of ordinary skill in the art to modify Alpert to include the sections as shown by Reynaud in order to make use of art known shapes to better fit within a tooth.

Art Unit: 3732

Claims 33-36, 38-52, 55-63, and 66-69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 5,915,970. Although the conflicting claims are not identical, they are not patentably distinct from each other because to use a non-woven material is an obvious matter of choice in the material used to one of ordinary skill in the art. To not include traction pulling in the process of forming is an obvious matter of choice in not using a method of step of making the claimed structure.

Claims 64 and 65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 5,915,970 in view of Reynaud et al (5328372). The '970 claims teach the structure as described above, however, do not show using a truncated cylindrical shape. Reynaud shows a series of truncated conical sections as shown in the drawings. It would be obvious to one of ordinary skill in the art to modify Alpert to include the sections as shown by Reynaud in order to make use of art known shapes to better fit within a tooth.

Claims 33-36, 38-63, and 66-69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 5,919,044. Although the conflicting claims are not identical, they are not patentably distinct from each other because to use a non-woven material is an obvious matter of choice in the material used to one of ordinary skill in the art. To not include

Art Unit: 3732

traction pulling in the process of forming is an obvious matter of choice in not using a method of step of making the claimed structure.

Claims 64 and 65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 5,919,044 in view of Reynaud et al (5328372). The '044 claims teach the structure as described above, however, do not show using a truncated cylindrical shape. Reynaud shows a series of truncated conical sections as shown in the drawings. It would be obvious to one of ordinary skill in the art to modify Alpert to include the sections as shown by Reynaud in order to make use of art known shapes to better fit within a tooth.

Claims 33-36, 38-63, and 66-69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,371,763. Although the conflicting claims are not identical, they are not patentably distinct from each other because to use a non-woven material is an obvious matter of choice in the material used to one of ordinary skill in the art. To not include traction pulling in the process of forming is an obvious matter of choice in not using a method of step of making the claimed structure.

Claims 64 and 65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S.

Art Unit: 3732

Patent No. 6,371,763 in view of Reynaud et al (5328372). The '763 claims teach the structure as described above, however, do not show using a truncated cylindrical shape. Reynaud shows a series of truncated conical sections as shown in the drawings. It would be obvious to one of ordinary skill in the art to modify Alpert to include the sections as shown by Reynaud in order to make use of art known shapes to better fit within a tooth.

Allowable Subject Matter

Claims 36 and 54 stand rejected under double patenting only.

Response to Arguments

Applicant's arguments filed July 7, 2003 have been fully considered but they are not persuasive. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

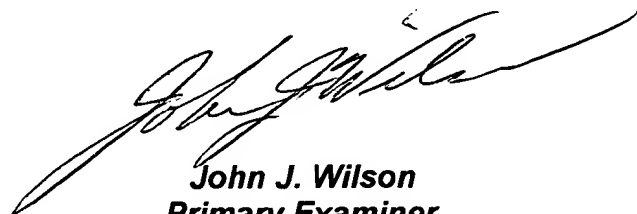
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3732

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to John Wilson at telephone number (703) 308-2699.



John J. Wilson
Primary Examiner
Art Unit 3732

jjw

August 22, 2003

Fax (703) 872-9306

Work Schedule: Monday through Friday, Flex Time